



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/652,101

08/28/2003

Jeffrey Capone

038927-0203

9858

23392 7590 05/03/2010

FOLEY & LARDNER
555 South Flower Street
SUITE 3500
LOS ANGELES, CA 90071-2411

EXAMINER

CASANOVA, JORGE A

ART UNIT

PAPER NUMBER

2159

MAIL DATE

DELIVERY MODE

05/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/652,101	Applicant(s) CAPONE ET AL.	
	Examiner JORGE A. CASANOVA	Art Unit 2159	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/2003 and 12/05/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-26 are presented for examination.
2. This Office action is **Non-Final**.

Information Disclosure Statement

3. The information disclosure statements (IDS) filed on 12/12/2003 and 12/05/2005 have been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 25-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a system which was described a software, *per se*, see ¶0050 of the instant specification regarding “the controller 718 may be, for example, one or more processors, software, firmware, hardware comprising hardwired logic, or any combination thereof”; Accordingly, the claims are not directed to a process, machine, manufacture, or composition of matter within the meaning of 35 U.S.C. 101; as such the claimed invention is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim element (s) “copying, receiving, modifying and sending” are means (or step) plus function limitation (s) that invokes 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2159

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Kloba et al. (US 2002/0046296 A1, also cited on the IDS dated on 12/12/2003) hereinafter "Kloba".

10. With respect to claims 1, 13, 14, 19, 20 and 25, the Kloba reference teaches methods and systems for synchronizing a transaction between devices having layered application architectures [see ¶0067, regarding sync operation of the invention includes various synchronization processes that can collect information from the Internet to a server, and to the client; The usage of the term "sync," as described herein, refers to the overall operation of connecting a client to a server for the exchange, interaction, creation, and removal of data] comprising:

copying a business logic layer of an application on a first device to an application on a second device [see ¶0069, regarding synchronization is meant to refer to the specific process of copying, adding, filtering, removing, updating and merging the information between a client and a server];

receiving, at the second device, a first transaction from the first device [see ¶0115, regarding during the synchronization process, the server 104 will load the client 108 with the selected channels; More particularly, the server 104 will load the client 108 with the objects associated with the channels];

modifying, in a business logic layer of the application on the second device, the first transaction received from the first device [see ¶0116, regarding the client 108 may process and use those objects when not connected to the server 104; also, see ¶0126,

regarding the server 104 may administer a calendar that may be installed on clients 108]; and

sending, from the second device to the first device, a second transaction [see ¶0126, regarding the synchronization of appointments, events and/or dates on this calendar between clients 108 and the server 104 may be performed by a calendar synchronization module],

wherein the business logic layer of the application on the first device reconciles the modified transaction with the original transaction [see ¶0069, regarding synchronization is meant to refer to the specific process of copying, adding, filtering, removing, updating and merging the information between a client and a server], and

wherein the first transaction has been modified by the business logic layer of an application on the second device to become the second transaction [see ¶0116, regarding the client 108 may process and use those objects when not connected to the server 104; also, see ¶0126, regarding the server 104 may administer a calendar that may be installed on clients 108; as interpreted by the Examiner, by having the client update a calendar, the client has already performed the process of converting a first transaction into a second transaction].

11. With respect to claims 2 and 15, Kloba teaches the methods of claims 1 and 15, as referenced above. Kloba further teaches wherein the business logic layer of the application on the second device mirrors the business logic layer of the application on the first device [see ¶0068, regarding syncing can be defined as mirroring data on a client and a server, such that the data is the same on client and server].

Art Unit: 2159

12. With respect to claims 3, 24 and 26, Kloba teaches the method and systems of claims 1, 19 and 25, as referenced above. Kloba further teaches wherein the second device is a mobile device [see ¶0052, regarding lists examples of mobile devices, although the invention is not limited to these examples].

13. With respect to claims 4 and 5, Kloba teaches the method of claim 1, as referenced above. Kloba further teaches wherein the first device is a laptop computer and server [see ¶0055, regarding software and methods for administering a server that manages the variables relevant to a mobile device/server environment; as maintained by the Examiner, one skilled in the art can install software on a laptop computer to convert the system into a server].

14. With respect to claim 6, Kloba teaches the method of claim 1, as referenced above. Kloba further teaches wherein the second device is a client [see ¶0067, regarding the sync operation of the invention includes various synchronization processes that can collect information from the Internet to a server, and to the client].

15. With respect to claims 7, 8, 17, 18, 22 and 23, Kloba teaches the methods and system of claims 1, 13 and 19, as referenced above. Kloba further teaches wherein in the step of sending, the transaction is sent over a network, wherein the network is the Internet [see ¶0055, regarding the invention includes technology for using applications on mobile devices that interact with the Internet or with intranets; The invention enables applications available via a network or via an Internet/intranet to download and to run on mobile devices].

16. With respect to claims 9, 16 and 21, Kloba teaches the methods and system of claims 1, 13 and 19, as referenced above. Kloba further teaches wherein in the step of sending, the transaction is sent via a wireless connection [see ¶0117, regarding the client 108A directly interacts with the server 104 via some transmission medium 120B, which may be any wired or wireless medium using any communication protocol].

17. With respect to claim 10, Kloba teaches the method of claim 1, as referenced above. Kloba further teaches wherein in the step of modifying, the transaction is modified while the second device is disconnected from the first device [see ¶0116, regarding the client 108 may process and use those objects when not connected to the server 104].

18. With respect to claim 11, Kloba teaches the method of claim 10, as referenced above. Kloba further teaches wherein the modified transaction is reconciled with the original transaction when the second device reconnects with the first device [see ¶0116, regarding the client 108 may process and use those objects when not connected to the server 104; also, see ¶0069, regarding upon pressing the sync button, the user initiates the sync operations of the present invention, wherein synchronization is meant to refer to the specific process of copying, adding, filtering, removing, updating and merging the information between a client and a server; interpreted by the Examiner, as reconciling upon reconnection with the server].

19. With respect to claim 12, Kloba teaches the method of claim 10, as referenced above. Kloba further teaches wherein further comprising tracking modifications made to the transaction [see ¶0224, regarding the device 106 or client 108 provides information

Art Unit: 2159

about itself and the content it wishes to receive in a single "up" transmission, and the server 104, upon identifying the device 106 or client 108, returns the desired information along with new synchronization changes in a single "down" transmission; Synchronization tokens are passed between client 108 and server 104 so that future transmissions only need to include the information which has changed since the last synchronization session].

Prior Art Made of Record

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- ❖ Wu teaches use of object signature property as a search parameter during synchronization of objects on a computer.
- ❖ Doman et al. teaches a system and method for incremental replication of changes in a state based distributed database.
- ❖ Huang et al. teaches a method and system for server synchronization with a computing device via a companion device.
- ❖ Lynch et al. teaches maintaining coherency in a symbiotic computing system and method of operation thereof.

Conclusions/Points of Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JORGE A. CASANOVA whose telephone number is

Art Unit: 2159

(571) 270-3563. The examiner can normally be reached on Mon. - Fri., 7:15 a.m. - 5:45 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James K. Trujillo can be reached on (571) 272-3677. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JORGE A CASANOVA/
Examiner, Art Unit 2159

/James Trujillo/
Supervisory Patent Examiner, Art
Unit 2159